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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,021	11/14/2001	Joseph Manuel Fernandez	INVIT1140-3	2174
7590	04/06/2004		EXAMINER	FRONDA, CHRISTIAN L
Lisa A. Haile, J.D., Ph.D. GRAY CARY WARE & FREIDENRICH LLP Suite 1100 4365 Executive Drive San Diego, CA 92121-2133			ART UNIT	PAPER NUMBER
1652				
DATE MAILED: 04/06/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/003,021	FERNANDEZ ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Christian L Fronda	1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 March 2004.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 41-66 is/are pending in the application.  
 4a) Of the above claim(s) 59-66 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 41-58 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 14 November 2001 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date 8/19/02; 10/21/02.

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Election/Restriction*

1. Applicants' election with traverse of Group I in the **RESPONSE TO RESTRICTION REQUIREMENT** dated 3/3/2004 is acknowledged. The traversal is on the grounds that because a search of one of the inventions would reveal art relevant to the other invention.

This is not found persuasive for reasons of record and because the invention of Group I is an expression vector comprising a nucleotide sequence of SEQ ID NO: 1 which is 27 nucleotides in length while the nucleic expression library comprises the nucleotide sequence of **CACC** which is patentable distinct from SEQ ID NO: 1. Thus, the products of Groups I and II are independent chemical entities and require different literature searches. Furthermore, Group I is directed toward an expression vector while Group II is directed toward a library of nucleic acids.

The requirement is still deemed proper and is therefore made FINAL

2. Claims 41-58 are under consideration in this Office Action.

### *Claim Rejections - 35 U.S.C. § 112, 1st Paragraph*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 41-58 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are genus claims that are directed toward any isolated expression vector comprising SEQ ID NO: 1 linked 5' to a start codon of any open reading frame of any nucleic acid from any biological source.

The scope of the claim includes many nucleic acids from many biological sources with widely differing structural, chemical, and physical characteristics, and the genus is highly variable because a significant number of structural differences between genus members is permitted.

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Genus members include nucleic acid molecule from any bacteria, any fungus, any vertebrate, any invertebrate, human, and yet to be discovered nucleic acid molecules encoding yet to be discovered proteins and enzymes.

However, the specification only describes an isolated expression vector comprising SEQ ID NO: 1 linked 5' to a start codon of yeast open reading frames (ORFs) where the yeast ORFs' expression has been analyzed by Western blot using anti-V5 antibody to detect an epitope tag.

The specification fails to provide a written description of additional representative nucleic acid molecules from any bacteria, any fungus, any vertebrate, and any invertebrate as encompassed by the genus claims. Applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise, and exact terms that a skilled artisan would recognize Applicants were in possession of the claimed invention.

***Conclusion***

5. No claim is allowed.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L Fronda whose telephone number is (571)272-0929. The examiner can normally be reached Monday-Friday between 9:00AM - 5:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura N Achutamurthy can be reached on (571)272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CLF



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